82. (Amended) The method of claim 81, further comprising the step of expanding

less than all of the candidate peptides determined in said representing step into their constituent compound isomers using a space-filling technique.

94. (Amended) The method of claim 74, wherein the first test peptide library consists of peptides having a length of no less than four amino acids.

95. (Amended) The method of claim 74, wherein the first test peptide library consists of peptides having a length no more than ten amino acids.

REMARKS

On page 2 of the Office Action, the Examiner acknowledged the election with traverse to elect claims 74-95 drawn to the species as recited. Applicants acknowledge that the restriction among groups I, IV and VIII has been withdrawn. Claim 74 is generic.

Support for the amendments to the claims is shown in the following table:

LIMITATION	SPECIFICATION SUPPORT
"space-filling technique"	Claim 75; page 10, lines 10-14.
"wherein the length of said test peptides comprises no greater than twenty amino acids"	Claim 94; claim 95; page 10, lines 18-25; page 25, line 21-30.
"at least one peptide"	Page 5, line 15; page 31, line 3 to page 32, line 16.
"satisfies"	Claim 74, preamble.
"quantifying or qualifying"	Page 7, lines 21-22; page 16, lines 5-14.
"wherein for said activity, the quantified or qualified indicia is greater than the indicia of the first library or less than the indicia of the first library"	Page 7, lines 15-18.
"peptides as isomers"	Page 45, lines 3-28.
"constituent compound isomers"	Page 45, line 29 to page 46, line 4.
tetramers and greater in size	Page 25, line 25
10-mers and lesser in size	Page 25, line 25

Accordingly, no prohibited new matter has been added and entry of the amendment of the claims is requested respectfully.

I. Summary of the Office Action

Claims 74-95 stand rejected under 35 U.S.C. §101 for allegedly lacking utility.

Claims 74-95 stand rejected under 35 U.S.C. §112, first paragraph, for allegedly not being supported by a specific or well-established utility.

Claims 74-78, 80-82 and claims dependent thereon stand rejected under 35 U.S.C. §112, first paragraph, for allegedly not being enabled.

Claims 74-78, 85, 94, 95 and claims dependent thereon stand rejected under 35 U.S.C. §112, second paragraph, for allegedly failing to point out and distinctly claim the invention.

Claims 74, 81, 87-90, 94 and 95 stand rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Tenson *et al.* (1997).

Claims 74, 92, 94 and 95 stand rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Ostrem *et al.* (1998).

Claim 74 stands rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Cho *et al.* (1998).

II. Summary of the Response

Claims 74, 77, 78, 80, 81, 82, 94 and 95 have been amended to more clearly describe the present invention. The Applicants traverse the outstanding rejections against pending claims 74, 76-84 and 86-95.

III. Rejection Under 35 U.S.C. §101: Utility

Claims 74-95 stand rejected under 35 U.S.C. §101, for allegedly lacking utility.

As claims 75 and 85 have been canceled, Applicants respectfully request that the rejection be withdrawn, as its stands against claims 75 and 85, as being moot.

Applicants respectfully traverse the rejection as it stands against pending claims 74, 76-84 and 86-95 and explain why the rejection does not apply below.

The Office Action states that " . . .utilities provided in the specification include identifying components and lead compounds, developing improved products for diagnostic applications , and providing an improved environment for cell research and drug discovery. These utilities are not specific . . ." Further, the Action recites that " . . . it is noted that merely disclosing the ability to make a compound or compounds (e.g. a library) is in itself insufficient utility to satisfy either 35 USC 101 or 112 first paragraph as determined by the U.S. Supreme Court. Eg. See *Brenner v. Manson*, 383 U.S. 519, 148 USPQ 689 (1966)."

Respectfully, the assertion by the Office Action that libraries are *per se* insufficient to satisfy 35 U.S.C. §§101 or 112 is not supported by fact. For example, examination of the patent database (www.uspto.gov) for 2001 using "library" as a search term will uncover issued patents, where nothing more than an "ability to make a compound or compounds," *i.e.*, a library, is the disclosed utility of the specification and the subject matter the claims (*e.g.*, U.S. Pat. No. 6,218,123, Issue Date: 17 April 2001). Thus, the assertion in the Office Action at page 6, ¶ 5 is without foundation.

The Office Action further cites *Brenner v. Manson* to support the lack of utility assertion. *Brenner* stands for the idea that where a product has no utility (*i.e.*, a steroid having no known properties), the method of making such a product also has no utility (*i.e.*, process for making such a steroid or intermediates thereof without utility). On the other hand, the product of the present invention (*i.e.*, the library and peptides comprised therein), has a utility, for example, of providing effective components for improved defined culture media (*e.g.*, peptides that increase protein production of cultured cells).

Moreover, the libraries themselves have "real world" (see, *e.g.*, companies listed below), commercial utility, and as noted in *Brenner*:

> "A patent system must be related to the world of *commerce* rather than the realm of philosophy." (Emphasis added).

Therefore, respectfully, as libraries are utile, the method or process of making such libraries is utile. Thus, *Brenner v. Manson* does not apply to the present set of facts.

In *Nelson v Bowler,* 626 F.2d 853, 206 USPQ 881 (CCPA 1980), also cited in the Action, the issue was whether an *in vitro* ("rough screening") or *in vivo* assay (BP assay) correlated to a practical utility as proof of reduction to practice for interference purposes (*i.e.*, determining a pharmacological versus therapeutic activity). In *Nelson*, such "rough screening" (*i.e.*, pharmacological activity) was held by the court to be a practical utility, even though such activity was not correlated to a therapeutic utility. As stated in Nelson:

> "Knowledge of the pharmacological activity of any compound is obviously beneficial to the public . . . Since it is crucial to provide researchers with an incentive to disclose pharmacological activities in as many compounds as possible, we conclude that adequate proof of any such activity constitutes a showing of practical utility." *Nelson*, at 883.

The synthesis of libraries, wherein such libraries allow for the rational selection of subsets of lead compounds for molecular optimization, is a practical utility in view of *Nelson* because such a selection process is "inherently beneficial to the public." In the spirit, if not the letter, of the opinion, Applicants' invention provides as many lead compounds as possible for rational molecular optimization of defined products. For example, see *e.g.*, Stanley *et al.*, Random Versus Rational: Which is Better for General

Compound Screening? at www.netsci.org/Science/Screening/feature09.html on the need for rational drug design methods, *i.e.*, real world value. Therefore, Applicants would respectfully argue that *Nelson* supports the "practical utility" of the present invention.

For *In re Kirk* (376 F.2d 936, 153 USPQ 48 (CCPA1967)), what was at issue was whether the "biological activity" disclosed in an affidavit could serve as support for insufficient disclosure in an application as filed. The present facts are distinguished from *In re Kirk,* as the biological activities of the present invention are disclosed in the application as filed (see *e.g.*, page 6, lines 5-22). Respectfully, the alleged "nebulous expression" and "vague assertions" as recited in the instant Office Action do not apply to the present specification or claims. Further, like *Cross v. Iizuka*, 753 F.2d 1040, 224 USPQ 739 (Fed. Cir. 1985), Applicants' arguments do not present " . . . a general allegation of 'biological activity' or 'biological properties' as was . . . in *Kirk*" since specific activities/functions that are modulated by media environment manipulation are expressly recited in the specification as filed (again see, *e.g.*, page 6, lines 5-22).

The assertions at page 7, ¶ 2, of the Office Action would suggest that there is no immediate benefit to the public. Respectfully, as suggested in Applicants' analysis of *Nelson v Bowler*, *supra*, providing as many lead compounds as possible for rational molecular optimization of defined products is an immediate benefit to the public as evidenced by the issuance of U.S. patents limited to such utility. Further, evidence can be seen for public benefit in the commercial success of companies manufacturing libraries (*e.g.*, Clonetech, Invitrogen, Novagen, OriGen Technologies, Obigene,

Stratagene, Edge Biosystems, American Peptide Co., Advanced ChemTec Inc., Princeton BioMolecules Group, Sigma-RBI, SynPep Corp. *et al.*).

In response to the assertion that disclosures limited to "identify and predict . . . new compounds" are *per se* non-utile, again, in view of the allowed patents having such disclosures (*e.g.*, U.S. Pat. Nos. 6,218,123, ID: 17 April 2001; 6,210,900, ID: 3 April 2001; and 6,174,669, ID: 16, January 2001), respectfully, this is just not the case (*supra*).

The Office Action also asserts that the method of the present invention is not a research tool in the sense of a screening assay or gas chromatography, stating that it is the subject of basic research, further asserting that the present invention has no established utility. However, the Office Action admits on the record that "the 'useful' requirement may be established by reference to a well established utility." According to §706.03(a)(1)(B)(2):

> "If the applicant has asserted that the claimed invention is useful for any particular purpose (*i.e.*, a "specific utility") and that assertion would be considered credible by a person of ordinary skill in the art, do not impose a rejection based on lack of utility. An invention has a well-established utility if a person of ordinary skill in the art would immediately appreciate why the invention is useful based on the characteristics of the invention (*e.g.*, properties of a product or obvious application of a process)."

Respectfully, the Office Action has not met the burden of demonstrating that one of ordinary skill in the art would not immediately appreciate why the invention is useful based on the properties of the library or application of the claimed method. For example, because the properties of the compounds desired by the skilled artisan would be select for his or her purpose, the present invention provides a flexible system such

that the parameters and indicia for generation of a library of compounds having predicted qualities are controlled by the end user. The end user would possess the compounds comprising the first library, and would be aware of those properties associated with it (*e.g.*, molecular weight, hydrophobicity as parameters and increased antibody production by cultured hybridoma cells as the indicia of activity).

The process generates data such that lead compounds, with similar properties of compounds known to and in possession of the end-user, are *rationally* identified, saving time, resources and money for such an end-user (*i.e.*, practical utility over that offered by random identification methods, see *e.g.*, Stanley *et al.*, *supra*). This is readily apparent from the specification, and would be an obvious application of the process to one of ordinary skill in the art. As such, respectfully, a rejection based on lack of utility should not be imposed on the present invention since said invention has a well established utility under the guidelines as disclosed in MPEP §706.03(a)(1)(B)(2).

The Office Action also asserts that "the specification fails to demonstrate the presence of a single identified peptide that meets a test requirement using the method claimed. The specification does not provide any guidance as to how one may screen for a test requirement." The specification demonstrates that, for example, at least one peptide has been identified which is based on a relationship between hydrophobicity, molecular weight and total charge (*i.e.*, at least one parameter) and an indicia of biological activity (*i.e.*, protein production as the measured first indicia of such at least one parameter). The test requirement to satisfy in this example is whether addition of such peptides to a culture medium enhances protein production by bacterial cells grown in such medium. Guidance for assaying for production of proteins is given at page 18,

lines 26 through 30. As such methods are well known in the art, it should be kept in mind it is well settled that:

> "[A] patent need not teach, and preferably omits, what is well known." *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 231 USPQ 81 (Fed. Cir. 1986), cert. denied; 480 U.S. 947 (1987).

Or more to the point:

> "A patent applicant need not include in the specification that which is already known to and available to the public." *Paperless Accounting, Inc. v. Bay Area Rapid Transit Sys.*, 804 F2d 659, 231 USPQ 649 (Fed. Cir. 1986).

As one skilled in the biotechnology and/or chemical arts would be highly skilled, knowledge of the Lowry (Lowry *et al.*, *J Biol Chem* (1951) 193: 265-275, at one time the most cited reference in biochemistry) or Bradford protein assay would be among the minimal skills possessed.

To continue, the identified peptide, based on the relationship (*i.e.*, between at least one parameter and a measured first indicia), is expected to provide an indicia of activity that satisfies the test requirement (*i.e.*, for example, a predicted activity of 28.2 based on regression analysis of the parameters and measured indicia, see page 32, Table 4). This is what is claimed in the application as filed and this is spelled out in the specification as filed at page 30, line 29 to page 32, line 16 (see also, Tables 3 and 4).

The Action seems to be requiring Applicant to supply more "than a reasonable showing that the invention will work to overcome the problem it addresses." Such a standard was felt to be too high according to the Federal Circuit (*Scott v. Finney*, 34 F.3d 1058, 1063, 32 USPQ2d 1115, 1120 (Fed. Cir. 1994)). Further, undue experimentation is not the test for utility, but in fact is the test for enablement. As the

last paragraph on page 9 and the second paragraph of page 10 are enablement tests (*i.e.*, undue experimentation), they shall be treated in the response under the enablement section.

Applicants, through argument and fact, have demonstrated the following: 1) that libraries (*i.e.*, methods to identify such) are not *per se* non-utile as seen in the existence of issued patents disclosing similar subject matter, 2) the present invention is inherently beneficial to the public in view of *Nelson*, 3) a well established utility of the invention is provided in the application, according to MPEP §706.03(a)(1)(B)(2), and 4) guidance within the standard of *Scott*, *i.e.*, a reasonable showing that the invention will work to overcome the problem it addresses is provided in the application. For these reasons, Applicants respectfully request that the rejection, as it stands against claims 74, 76-84 and 86-95, be withdrawn.

IV. Rejections Under 35 U.S.C. §112, First Paragraph: Enablement due to lack of Utility

Claims 74-95 stand rejected under 35 U.S.C. §112, first paragraph, because allegedly the assertion of a lack of utility concomitantly asserts an inability by one of skill in the art to know how to use the invention. As claims 75 and 85 have been canceled, Applicants respectfully request that the rejection be withdrawn, as its stands against claims 75 and 85, as being moot.

Applicants respectfully traverse the rejection as it stands against pending claims 74, 76-84 and 86-95.

Applicants have provided reasoning above to explain why the utility rejection should be withdrawn. To summarize, Applicants have demonstrated that: 1) libraries (*i.e.*, methods to identify such) are not *per se* non-utile 2) the present invention is inherently beneficial to the public, 3) the invention specification provides well-established utility, and 4) guidance is provided within the standard of the Federal Circuit in *Scott*. Moreover, the instant application clearly sets forth how to make a library of interest (see, *e.g.*, at page 19, line 15 to page 26, line 17) and then how to use the library (see, *e.g.*, at page 30, line 29 to page 32, line 16). For these reasons, Applicants respectfully request that the rejection, as it stands against claims 74, 76-84 and 86-95, be withdrawn.

V. Rejections Under 35 U.S.C. §112, First Paragraph: Enablement

Claims 74-78, 80-82 and claims dependent thereon stand rejected under 35 U.S.C. §112, first paragraph, as allegedly being non-enabled.

As claims 75 and 85 have been canceled, Applicants respectfully request that the rejection be withdrawn, as its stands against claims 75 and 85, as being moot.

Applicants respectfully traverse the rejection as it stands against pending claims 74, 76-82 and claims dependent thereon.

At the outset, Applicants are not clear as to what the Office Action means by the phrase "and claims dependent thereon" since, for example, claims 80-83 are dependent on claim 74. Further, as all of the claims within the elected group are dependent from claim 74, the point of the phrase is obscure.

For the record, the Office Action expressly admits at page 11, ¶ 2, "because the

specification, while being enabling for short peptides (i.e., < 20 amino acids) for which the activity, indicia of activity, method for testing indicia, and relationship between indicia and whole molecule parameters are already well established . . .", thus indicating that the instant specification contains an enabling disclosure as written. Moreover, as the claims have been amended to include length elements that correspond to those elements admitted in the Office Action to possess the enumerated enabling qualities, Applicants request that the "enablement" rejection be withdrawn as moot in view of such an express admission and amendments herein. Notwithstanding, the Office Action raised issues that Applicants now respond to.

The Office Action again requests disclosure which goes beyond that required by the Federal Circuit in *Scott*, reciting that steps "critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure," citing *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). As stated above, all that is required is "a reasonable showing that the invention will work to overcome the problem it addresses." *Scott v. Finney*, 34 F.3d 1058, 1063, 32 USPQ2d 1115, 1120 (Fed.Cir. 1994). Moreover, there is no need to teach what is known in the art. *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 231 USPQ 81 (Fed. Cir. 1986), cert. denied; 480 U.S. 947 (1987). Further, as distinguished from *Mayhew*, there is no equivalent in the instant specification to the "specifically located . . . cooling zone" at issue in *Meyhew* (see *Id.*, at 358). Thus, while scope of the claims is broad, such scope is within the abilities of the skilled artisan using the guidance provided by the specification and the state of the art, as will be demonstrated below.

The Office Action asserts that claim 74 encompasses "any peptide, indicia, activity and test requirements, the combinations of which are essentially limitless." Again, in view of the admission of Office Action as to what is enabled (*supra*), and further in view of the amendments herein, this assertion is inapposite.

The Office Action also states that, " [t]he current state of the art, based upon the references sited[sic], does not enable the scope of claim 74 which includes virtually infinite numbers of peptide libraries and only vague guidance as to the methods to be used for determining relationships between whole molecule parameters and measured indicia (i.e., structure-function relationships)." Again, in view of the admission of Office Action as to what is enabled (*supra*), and further in view of the amendments herein, this assertion is also inapposite.

With respect to the term "operations" (also to respond to the same assertions in the utility rejection), at page 51, lines 11 and 12, the specification reads, "Operations to determine the relationship are carried out by any means known in the art, preferably, as described in Block 104 and 306." (These refer to blocks of Figures 1 and 3, respectively). From these blocks, "operations" are means to determine relationships. For example, the indicia relationship operations are expanded further at page 30, lines 19-25. In another example, the distance function operations are expanded further at page 34, lines 24-34. At page 33, lines 9-16, preferred operations are described. Further embodiments for operations can be found at page 26, lines 18-26 and page 27 at lines 11-21. Moreover, the parameters and indicia clearly are known to the artisan. The selection thereof and means to assay same are no more than a design choice of the artisan. In no instance there is an equivalent to a requisite step, *i.e.*, an operation can

only be carried out in a particular manner if the process is to perform the designed function, as was at issue in *Meyhew*. Applicants do not agree that the specification only provides lists. Such an interpretation overlooks the disclosure of the Figures as filed. Accordingly, Applicants respectfully sustain that the specification provides the appropriate guidance.

The Office Action also asserts that the specification provides: 1) no means of applying a space-filling technique to test peptides, 2) no means for measuring or estimating first indicia, 3) no means of determining a range of acceptable indicia of the activity and 4) no means of determining how a plurality of second test peptides determined from the estimated indicia are within the range of acceptable indicia. Applicants will address each issue separately.

Applying space-filling models (minimax and maximin as well as genetic algorithms) can be found at page 19, line 24 to page 24, line 11, including references.

Measuring first indicia can be found at page 6, lines 5-22 (general); page 18, line 9 to page 19, line 9 (particular measures); page 26, lines 18-26 (operations to determine a desired indicia, also page 29, line 27 to page 30, line 2, indicia of second library); and page 31, lines 9-11 (example of indicia of a property, where as noted above, measuring proteins is well known in the art).

Determining range of acceptable indicia can be found at page 7, lines 10-23.

Determining how a plurality of second test peptides determined from the estimated indicia are within the range of acceptable indicia can be found at page 29, lines 16-26; page 32, lines 5-16 and page 35, line 21 to page 37, line 8.

Last, the Office Action states that the specification does not describe the following: 1) means of determining a distance function between a first value of a whole molecule parameter of a first and second whole molecule parameter, 2) a means of estimating indicia of activity of a second test peptide or cutoff distance, 3) how a first peptide library is defined or what constitutes a "candidate peptide," 4) an algorithm to determine which peptides to use, how many, or which isomers, and 5) how to expand or under what circumstances to do so. Applicants will address each issue below.

Means of determining distance can be found at page 8, line 27 to page 9, line 17, including a reference (general); page 34, lines 13-33 (using $d(x_1, x_2)$, including cutoffs and example) and page 35, line 1 to page 39, line 34 (including example for second test peptides and cutoff).

A means of estimating indicia of activity of a second test peptide or cutoff distance can be found at page 35, line 1 to page 39, line 34.

How a first peptide is defined can be found at page 19, line 15 to page 26, line 17 (space-filling designs, rationale, minimax, references etc.), see especially page 24, line 12 to page 26, line 5.

What constitutes a candidate peptide can be found at page 36, line 4-6.

Algorithms to determine peptides can be found at page 10, line 30 to page 11, line 9; page 19, line 15 to page 21, line 4 (especially page 20, lines 18-21) and page 24, lines 9-11.

How or under what circumstance one expands can be found at page 11, lines 10-20 and lines 24-34 and page 45, line 29 to page 48, line 18.

As such, the specification provides the necessary guidance to enable one skilled in the art to make and to use the instant invention. For these reasons, Applicants respectfully request that the rejection, as it stands against claims 74, 76-84 and 86-95, be withdrawn.

VI. Rejections Under 35 U.S.C. §112, Second Paragraph

Claims 74-82, 85, 94, 95 and claims dependent thereon stand rejected under 35 U.S.C. 112, second paragraph for allegedly failing to point out and distinctly claim the invention.

As claims 75 and 85 have been canceled, Applicants respectfully request that the rejection be withdrawn, as it stands against claims 75 and 85, as being moot.

Applicants respectfully traverse the rejection as it stands against pending claims 74, 76-82, 85, 94 and 95 and claims dependent thereon.

For claim 74, the Office Action states that "[i]t is not clear whether applicant intends the method to identify a single peptide in the first peptide library, a single peptide in the second peptide library, or a second test peptide library." While not acquiescing to the reasoning of the Examiner, and to expedite prosecution toward allowance, claim 74 has been amended to identify "at least one peptide" from a second peptide library.

For claims 74, 77, 78, 80, 91 and dependent claims thereon, the Office Action asserts that "[t]he phrase 'indicia of an activity' is vague and . . . it is not clear if there is a difference between 'activity' and 'indicia of an activity'." By "indicia" Applicants are using the plain definition, *i.e.*, something that serves to indicate; a sign (*The*

American Heritage College Dictionary, 3rd ed., (1997), Houghton Mifflin Company, Boston, MA.). Thus, an "indicia of an activity" would be a sign of activity (*e.g.*, qualitative or quantitative change in the amount of protein produced. See also, Cho *et al., J Chem Inf Comput Sci* (1998) 38, 259-268, abstract and at page 260, column 2, paragraph 2).

For claim 75, the Office Action asserts that "it is not clear . . . what means of selection constitutes a space-filling technique . . . The claim is unclear as to applicants intent." Applicants point to page 10, lines 6-16, wherein space filling is exemplified, including what designs fall under its rubric.

For claim 76, the Office Action asserts that the distinction between "parameter" and "whole molecule parameter" is unclear. Applicants point to page 28, lines 2-4 where "whole molecule parameter" is defined, "parameter" is differentiated at page 28, lines 11-26.

For claims 77, 78 and claims dependent thereon, the Office Action asserts that the term "acceptable" is indefinite. While not acquiescing to the reasoning of the Examiner, and to expedite prosecution toward allowance, claims 77 and 78 have been amended to more clearly define the invention (see table, *supra*, for specification support).

For claim 79, the Office Action asserts that the phrase "non-parametric regression formula" is unclear. By the phrase "non-parametric regression formula," Applicants are using the art recognized definition, i.e., for ($\hat{y}$) no assumption is made about the function of (f) except for smoothness (see also, http://stat.tamu.edu/ftp/pub/rjcarroll/jeffmaca.directory/biometrika.directory/asa98.pdf).

For claim 81, the Office Action asserts that the term "candidate peptide" is indefinite. The specification provides a standard for candidate peptides using the nearest neighbor rule, for example at page 36, lines 4-6.

For claim 81, the Office Action asserts that the term "peptide isomers" is repugnant to the usual meaning of the term. While not acquiescing to the reasoning of the Examiner, and to expedite prosecution toward allowance, claim 81 has been amended to more clearly define the invention (see table, *supra*, for specification support).

For claim 82, the Office Action asserts that the term "compound peptide" is unclear. While not acquiescing to the reasoning of the Examiner, and to expedite prosecution toward allowance, claim 82 has been amended to more clearly define the invention (see table, *supra*, for specification support).

For claims 94 and 95, the Office Action asserts that use of the term "about" renders the claims indefinite. While not acquiescing to the reasoning of the Examiner, and to expedite prosecution toward allowance, claims 94 and 95 have been amended to more clearly define the invention (see table, *supra*, for specification support).

For claim 94, the Office Action asserts that "[i]t is not clear whether claim 94 limits the first peptide library, the second test peptide library, or both test peptide libraries" with respect to the range of peptide having a length element. Applicants point to page 10, lines 17-25. The relative sizes of the first and second libraries are not necessarily linked. Further, the amendment to claim 74 makes plain which library has the size element correspondence (*i.e.*, the first library from which the enabled relationship is established).

For claim 95, the Office Action asserts that "[i]t is not clear whether claim 94[sic] limits the first peptide library, the second test peptide library, or both test peptide libraries" with respect to the range of peptide having a length element. Again, Applicants point to page 10, lines 17-25. The relative sizes of the first and second libraries are not necessarily linked. Further, the amendment to claim 74 makes plain which library has the size element correspondence (*i.e.*, the first library from which the enabled relationship is established).

For the reasons stated above, the claims are clear and distinct, and Applicants respectfully request that the rejection as it stands against claims 74-82, 85, 94, 95 be withdrawn.

VII. Rejections Under 35 U.S.C. §102(b)

Claims 74, 81, 82, 87-90, 94, and 95 stand rejected under 35 U.S.C §102(b) as allegedly being anticipated by Tenson *et al* (1997).

While not acquiescing to the reasoning of the Examiner, and to expedite prosecution toward allowance, claim 74 has been amended to incorporate the limitations of claim 75. The Office Action has intimated, by not rejecting claim 75, which contains the "space-filling" element, that such an element when combined with the elements of the claim from which it depends (namely claim 74), said amended claim 74 is not anticipated by the cited reference. As claim 74 has been so amended, Applicants respectfully request that the rejection, as it stands against claims 74, 81, 82, 87-90, 94, and 95, be withdrawn for the reasons given above.

Claims 74, 92, 94 and 95 stand rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Ostrem *et al* (1998).

While not acquiescing to the reasoning of the Examiner, and to expedite prosecution toward allowance, claim 74 has been amended to incorporate the limitations of claim 75. The Office Action has intimated, by not rejecting claim 75, which contains the "space-filling" element, that such an element when combined with the elements of the claim from which it depends (namely claim 74), said amended claim 74 is not anticipated by the cited reference. As claim 74 has been so amended, Applicants respectfully request that the rejection, as it stands against claims 74, 92, 94 and 95, be withdrawn for the reasons given above.

Claim 74 stands rejected under 35 U.S.C. §102(b) as being allegedly anticipated by Cho *et al* (1998).

While not acquiescing to the reasoning of the Examiner, and to expedite prosecution toward allowance, claim 74 has been amended to incorporate the limitations of claim 75. The Office Action has intimated, by not rejecting claim 75, which contains the "space-filling" element, that such an element when combined with the elements of the claim from which it depends (namely claim 74), said amended claim 74 is not anticipated by the cited reference. As claim 74 has been so amended, Applicants respectfully request that the rejection, as it stands against claim 74 be withdrawn for the reasons given above.

CONCLUSION

Applicants have taken substantial steps to advance prosecution. Reexamination, reconsideration, withdrawal of the rejections and early indication of allowance are requested respectfully. If any questions remain, the Examiner is urged respectfully to contact the undersigned at the local exchange provided below.

The Commissioner hereby is authorized to charge payment of any fees under 37 C.F.R. § 1.17 that may become due in connection with the instant application or credit any overpayment to Deposit Account No. 18-2220.

Respectfully submitted,

Dean H. Nakamura
Reg. No. 33,981

Correspondence Address:

Roylance, Abrams, Berdo & Goodman, L.L.P.
1300 19th Street, N.W., Suite 600
Washington, D.C. 20036
(202) 659-9076

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